

REMARKS

Applicant submits this Amendment in response to the non-final Office Action mailed July 29, 2003. Claims 23-34 and 58-79 are pending in the Application.

Claims 23-27, 59-65, 67-79 stand rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 5,825,308 (Rosenberg). Dependent claims 28, 58, and 66 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rosenberg in view of U.S. Patent No. 5,450,079 (Dunaway). Dependent claim 29 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Rosenberg in view of U.S. Patent No. 5,631,669 (Stobbs).

Applicant has amended claims 23 and 71. Support for the amendments above can be found in the specification and claims as filed. No new matter has been added. Applicant respectfully submits that the pending claims are patentable for the reasons set forth below. Consideration of the pending claims is respectfully requested in view of the foregoing and the following remarks.

A. Claims 23-27, 59-65, 67-79

Claims 23-27, 59-65, and 67-79 stand rejected under 35 U.S.C. § 102(e) as anticipated by Rosenberg. The rejection is improper because Rosenberg does not disclose each and every element of the claims at issue. A claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. See MPEP § 2131 (citing *Verdegel Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987)).

Independent claims 23 and 71 each claim “an actuator disposed within said volume of said manipulandum.” Claims 24-27, 59-65, and 67-70 depend ultimately from independent claim 23. Claims 72-79 depend ultimately from independent claim 71.

Rosenberg does not disclose an apparatus that includes “an actuator disposed within said volume of said manipulandum,” as claimed. In contrast, Rosenberg describes actuators coupled to a mechanical interface 14. (*See* Rosenberg at col. 7, lines 35-39 and Figure 2). As disclosed in Rosenberg, the mechanical interface 14 interfaces mechanical input and output between a user manipulatable object 12 and a host computer 18. (*See* Rosenberg at col. 7, lines 12-15). Thus, Rosenberg does not disclose each and every element of independent claims 23 and 71.

As Rosenberg does not disclose each and every element of each of independent claims 23 and 71, Applicant respectfully submits that independent claims 23 and 71 are each patentable over Rosenberg. Claims 24-27, 59-65, and 67-70 depend ultimately from independent claim 23 and claims 72-79 depend ultimately from independent claim 71 and are, therefore also allowable for the same reasons as independent claims 23 and 71. Accordingly, the rejection to claims 23-27, 59-65, and 67-79 should be withdrawn and the claims allowed.

B. Claims 28, 58, and 66

Claims 28, 58, and 66 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rosenberg in view of Dunaway. Claims 28, 58, and 66 depend ultimately from independent claim 23.

One of the criteria for a prima facie case of obviousness is that “the prior art reference (or references when combined) must teach or suggest all the claim limitations.” *See* MPEP § 2143. The cited references do not teach or suggest all the claim elements of independent claim 23.

Dependent claims include all of the elements of the claim from which they depend. Thus, each of dependent claims 28, 58, and 66 includes “an actuator disposed within said volume of said manipulandum.” As discussed above, Rosenberg does not disclose “an actuator disposed within said volume of said manipulandum,” as claimed.

The Office Action cites Dunaway for teaching “a handheld remote device which comprises a local display with touch panel and a local processor, separate from the host processor and operative to communicate with the host processor similar to Rosenberg.” (Paper No. 14 at 4). Dunaway, however, does not disclose an apparatus that includes “an actuator disposed within said volume of said manipulandum,” as claimed. Thus, neither Rosenberg nor Dunaway teaches or suggests, singularly or in combination, all the claim elements of each of claims 28, 58, and 66.

As neither Rosenberg nor Dunaway teaches or suggests, singularly or in combination, all the claim elements of each of claims 28, 58, and 66, Applicant respectfully submits that claims 28, 58, and 66 are each patentable over Rosenberg in view of Dunaway. Accordingly, the rejection to claims 28, 58, and 66 should be withdrawn and the claims allowed.

C. **Claim 29**

Dependent claim 29 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Rosenberg in view of Stobbs. Claim 29 depends ultimately from independent claim 23.

One of the criteria for a prima facie case of obviousness is that “the prior art reference (or references when combined) must teach or suggest all the claim limitations.” *See* MPEP § 2143. The cited references do not teach or suggest all the claim elements of independent claim 23.

Dependent claims include all of the elements of the claim from which they depend. Thus, dependent claim 29 includes “an actuator disposed within said volume of said manipulandum.” As discussed above, Rosenberg does not disclose “an actuator disposed within said volume of said manipulandum,” as claimed.

The Office Action cites Stobbs for teaching “an input device [i.e., microphone] similar to Rosenberg.” (Paper No. 14 at 4). Stobbs, however, does not disclose an apparatus that includes “an actuator disposed within said volume of said manipulandum,” as claimed. Thus, neither Rosenberg nor Stobbs teaches or suggests, singularly or in combination, all the claim elements of claim 29.

As neither Rosenberg nor Stobbs teaches or suggests, singularly or in combination, all the claim elements of claim 29, Applicant respectfully submits that claim 29 is patentable over Rosenberg in view of Stobbs. Accordingly, the rejection to claim 29 should be withdrawn and the claim allowed.

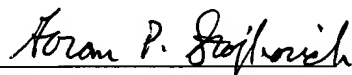
CONCLUSION

Applicant respectfully submits that the pending claims are allowable.

Applicant respectfully solicits the issuance of a timely Notice of Allowance for all pending claims. The Examiner is invited to contact the undersigned by telephone to discuss any matter related to the Application.

Respectfully submitted,

Dated: December 4, 2003


Goran P. Stojkovich
Registration No. 45,841

Kilpatrick Stockton LLP
1001 West Fourth Street
Winston-Salem, NC 27106-2400
Telephone: (336) 607-7300
Facsimile: (336) 607-7500